



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/183,791 10/30/98 JACOVES

P FMSI-24,440

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EXAMINER

SATTIZAHN, B

ART UNIT

PAPER NUMBER

2762

DATE MAILED:

11/10/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/183,791

Applicant(s)

Jacoves et al.

Examiner

Brian Sattizahn

Group Art Unit

2762

☒ Responsive to communication(s) filed on Oct 15, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-46

is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement..

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Oct 15, 1999 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2762

DETAILED ACTION

Applicant's Amendment filed on October 15, 1999 has been fully considered by the Examiner. Any objections or rejections that are not repeated herein have been withdrawn by the Examiner.

Status of Claims

Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph.

Claims 1-3, 7, 14-21, 23, 25-27, 31, 36-43 and 45 are rejected under 35 U.S.C. 102(b).

Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44 and 46 are rejected under 35 U.S.C. 103(a).

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on October 15, 1999 have been approved.

Response to Arguments

2. Applicant's arguments filed on October 15, 1999 have been fully considered but they are not persuasive with regard to the rejections Claims 1-46 under 35 U.S.C. 102(b) or 35 U.S.C. 103(a).

Art Unit: 2762

Applicant argued that Claims 1 and 25, as currently amended, are not anticipated by the Greer et al. reference, EP 0 511 463. Specifically, Applicant argued that Greer et al. does not disclose the operation of providing a discount on a redemptionable item through the purchase of discount triggering products.

The Examiner respectfully disagrees with Applicant's position and maintains his rejection of Claims 1 and 25, as currently amended, as being anticipated by Greer et al. Greer et al. discloses the generating of a cumulative discount certificate for use in a later transaction (see Col. 3, lines 52-55). Furthermore, in giving the claims their broadest reasonable interpretation, the Examiner is interpreting the phrase "generating a redemption value for a redemptionable item" as describing that the redemption value is applied to any item that could be redeemed by a purchaser. Using this interpretation, Greer et al. discloses Applicant's newly added limitation of "the single redemption value represents a discount that can be applied to a purchase transaction wherein the redemption item comprises at least a portion of the purchase transaction" (see Col. 2, line 57 to Col. 3, line 5, describing the applying of the amount of the discount certificate to the customer order, which order would inherently have redemptionable items using the Examiner's above discussed interpretation of redemptionable items). Thus, the Examiner maintains his rejection of Claims 1 and 25, as currently amended, under 35 U.S.C. 102(b) as anticipated by the Greer et al. reference.

With regard to the remaining claims, as Applicant's arguments are similar to those presented above the Examiner refers Applicant to the above discussion.

Art Unit: 2762

Therefore, in view of the above comments, the Examiner maintains his rejection of Claims 1-46 under 35 U.S.C. 102(b) or 35 U.S.C. 103(a) for the reasons given in the prior Office Action, paper no. 4.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 13-14 and Claim 25, line 15, recite the phrase "can be applied" which renders the scope of the claims indefinite because it is not certain whether or not the subject matter of the limitation is part of the claimed invention.

Claims 2-24 and 26-46 are rejected as depending from a rejected base claim.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fredregill et al., Raphel and Turcski all disclose types of coupon systems.

Art Unit: 2762

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Art Unit: 2762

Or:

(703) 308-1396, (for informal or draft communications, please label
"PROPOSED" OR "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Sattizahn whose telephone number is (703) 305-3891. The examiner can normally be reached on Monday-Thursday from 7:15am to 4:45pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz, can be reached on (703) 305-9643. The fax phone number for this Group is (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

BS

bts

November 5, 1999



ERIC W. STAMBER
PRIMARY EXAMINER